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APR 24 2005

TECHNOLOGY CENTER 3600

In re Application of :
Joel Ronning et al :
Serial No. 09/492,844 : **DECISION ON PETITION**
Filed January 27, 2000 : **FILED UNDER 37 CFR 1.181**
For: APPARATUS AND METHOD :
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OF FILES :

This is a decision on the Petition under 37 CFR 1.81 filed January 4, 2005 requesting the removal of the finality of the Office action mailed out on October 4, 2004.

The petition is DENIED as indicated below.

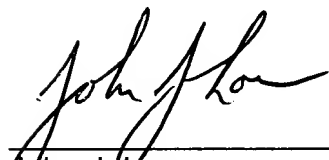
Applicants allege that in the Office action mailed out on October 4, 2004, the examiner raised two issues on the record for the first time. The two issues are: 1) whether applicants are entitled to a priority claim, and 2) a claim rejection under 35 USC 101.

A review of the application file record shows that a non-final rejection was mailed out on November 20, 2002. Applicants filed an amendment and response to the non-final rejection, along with an extension of time on April 2, 2003. A final rejection was mailed on June 13, 2003. Applicants filed a Request for Continued Prosecution (RCE) on November 13, 2003. A non-final rejection in response to the RCE was mailed on February 2, 2004. Applicants filed an amendment and response to the non-final rejection, along with a second extension of time on July 2, 2004. The final rejection in question was then mailed on October 4, 2004.

In the amendment filed on July 2, 2004, applicants made amendments to claim 1 both adding and deleting claim language. Thus, the new ground of rejection under 35 USC 101 in the examiner's final Office action mailed on October 4, 2004 was necessitated by applicants' amendment to the claims. In accordance with MPEP 706.07(a), the finality of the examiner's Office action was proper.

Please note that MPEP 706.07(a) specifically sets forth that the claims in an application shall be finally rejected in a second or subsequent action on the merits, except where the examiner introduces a new ground of rejection that is neither necessitated by applicants' amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). There is no basis for holding a final rejection improper or premature based on the raising of new issues, such as the issue of whether applicant is entitled to a priority claim as noted by applicants. Thus, the issue of whether applicants are entitled to a priority claim raised by the examiner in the final Office action mailed on October 4, 2004 is not grounds to withdraw the finality of the Office action.

It is for the foregoing reasons that the finality of the Office action mailed on October 4, 2004 is held to be proper.



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